



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,614	02/01/2006	Koji Hirose	P28570	5456
52123 7590 05/21/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER HARTMAN JR, RONALD D	
			ART UNIT	PAPER NUMBER
			2121	
			NOTIFICATION DATE	DELIVERY MODE
			05/21/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary

Application No.

10/550,614

Applicant(s)

HIROSE ET AL.

Examiner

Ronald D. Hartman Jr.

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

Figures 7-8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Figures 7-8 should be labeled as Prior Art as the applicant has readily admitted that both Figures represent a conventional system and method, respectively, and since both Figures have been included in the Background Art section of the applicant's specification.

Claim Interpretations

As per claims 1-12, "unique" is believed to represent relative terminology. That being said, the applicant's Abstract disclosure has provided that "Device *unique* data which is information *specific* to the controlled device is stored in the remote control device or the controlled device." Therefore, the examiner has interpreted *unique* to correspond to *specific*, with respect to data associated with the controlled device.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-4, 5 and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1, 3-4, 5 and 7-8, "type" is considered to be a relative term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Piepho et al., U.S. Patent No. 6,704,401.

As per claim 5, Piepho et al. teaches a method comprising:

- storing device information representing a kind of controlled device, the information being stored in the controlled device (e.g. interpreted to correspond to serial number information being stored in the controlled device; e.g. Figures 1-2, C4 L22-39, C4 L50-52, C5 L 1-3, C5 L31-45 and C6 L49-60);
- reading the stored device kind information from the controlled device (e.g. interpreted to correspond to a step of receiving the serial number by a configuration server; e.g. Figures 1-2, C4 L22-39, C4 L50-52, C5 L 1-3, C5 L31-45 and C6 L49-60);
- storing device *specific* data which is information *specific* to the controlled device in a remote control device (e.g. interpreted to correspond to a step of having a database of configuration related information about an appliance; e.g. Figures 1-2, C4 L22-39, C4 L50-52, C5 L 1-3, C5 L31-45 and C6 L49-60);
- extracting the *specific* data from the stored *specific* data based on the device representative of the kind of controlled device data (e.g. interpreted to

Art Unit: 2121

correspond to a step of determining which configuration related information will be utilized based on the serial number of the controlled device; e.g. Figures 1-2, C4 L22-39, C4 L50-52, C5 L 1-3, C5 L31-45 and C6 L49-60); and

- generating web display data on the basis of the extracted device *specific* data to transmit the web display data to a terminal (e.g. interpreted to correspond to generating data that would allow a user of a terminal, or PC, the capability to interact with the configuration steps via a web-based application, such as a browser; e.g. Figures 1-2, C4 L22-39, C4 L50-52, C5 L 1-3, C5 L31-45 and C6 L49-60).

As per claim 1, the applicant claims a system that includes several extra recitations, with regards to the method claimed by way of pending claim 5. However, upon closer inspection, it appears that all of the features are adequately disclosed by, or rendered inherent to, the functions and or capabilities of Piepho et al. Therefore, the rejection of claim 5, from above, holds *mutatis-mutandis* for the system of elements of pending claim 1.

As per claim 6, Piepho et al. teaches a method comprising:

- storing information *specific* to a controlled device, the *specific* information being stored in the controlled device (e.g. interpreted to correspond to serial number information being stored in the controlled device; e.g. Figures 1-2, C4 L22-39, C4 L50-52, C5 L 1-3, C5 L31-45 and C6 L49-60);

- reading the device *specific* information from the controlled device (e.g. interpreted to correspond to a step of receiving the serial number by a configuration server; e.g. Figures 1-2, C4 L22-39, C4 L50-52, C5 L 1-3, C5 L31-45 and C6 L49-60); and

- generating web display data on the basis of the received device *specific* data to transmit the web display data to a terminal (e.g. interpreted to correspond to generating data that would allow a user of a terminal, or PC, the capability to interact with the configuration steps via a web-based application, such as a browser; e.g. Figures 1-2, C4 L22-39, C4 L50-52, C5 L 1-3, C5 L31-45 and C6 L49-60).

As per claim 2, the applicant claims a system that includes several extra recitations, with regards to the method claimed by way of pending claim 1. However, upon closer inspection, it appears that all of the features are adequately disclosed by, or rendered inherent to, the functions and or capabilities of Piepho et al. Therefore, the rejection of claim 6, from above, holds mutatis-mutandis for the system of elements of pending claim 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piepho et al., as applied to claims 1-2 and 5-6, from above.

As per claims 3-4 and 7-12, Piepho et al. does not specifically teach the controlled device being a video recording device.

Perry et al. teaches a method and system for configuring a VCR, wherein a recording speed may be configured remotely (e.g. Abstract and Figure 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the features disclosed by Perry et al. into the system disclosed by Piepho et al. for the purpose of allowing video recording appliances to be configured remotely.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicants admission of prior art, in view of Piepho et al., U.S. Patent No. 6,704,401.

As per claims 1-2 and 5-6, the applicant has admitted that Figures 7-8 are prior art and these Figures adequately disclose all of the claimed features and or limitations except that the Figures do not show or utilize the claimed "unique data storage section"

(Figure 1 element 215) nor the "device unique data analyzer" (Figure 1 element 213), with regards to the server (Figure 1 element 210).

Piepho et al. adequately discloses features that are believed to correspond to the missing features in that Piepho et al. discloses the utilization of several databases related to the configuration of an appliance (e.g. Figure 1 element 120-122), wherein the information contained in these databases is used in conjunction with obtaining the serial number about the appliance, so as to allow for a user to remotely configure the appliance.

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Piepho et al. into the admitted prior art for the purpose of allowing the server the ability to configure numerous appliances made by different vendors or manufacturers, thereby providing a flexible configuration system allowing a user to remotely configure an appliance.

As per claims 3-4 and 7-12, the applicant has readily admitted that the features contemplated by these pending claims are features that were well known in the art at the time the invention was made (e.g. See Background Art section, pages 1-4).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D. Hartman Jr. whose telephone number is (571) 272-3684. The examiner can normally be reached on Mon.-Fri., 11:00 - 8:30 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on (571) 272-3687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

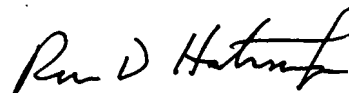
Art Unit: 2121

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronald D Hartman Jr.

Patent Examiner

Art Unit 2121



May 9, 2007

RDH

x ROH